

Claim Rejections-35 U.S.C. §112

Claim 85-90 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner has stated that Applicant has failed to disclose an electrical controller in the specification.

Applicant disagrees. The MPEP states that the standard for determining whether the specification meets the enablement requirement is whether any person skilled in the art can make and use the invention without undue experimentation (see MPEP §2164.01). Throughout the specification, the claimed controller is described as an electrical controller. As one example, the specification provides:

Controller 2 provides a telecommunications or electronic communications link coupled between the master station and the slave station. Controller 2 typically includes a computer. Controller 2 receives a command from the input device of master station 1 and relays this command to slave station 3. (page 15, lines 12-15 of the specification)(emphasis added).

Fig. 14 and the accompanying text describe a controller comprising a host CPU 700, interface board 704, and module boards 706. These are clearly electronic components, thereby making the controller an electrical controller.

Thus, the specification does describe an electrical controller in such a way that it would allow one of ordinary skill in the art to make or use the invention of claim 85 without undue experimentation. To the extent that the Examiner meant to reject claims 85-90 as failing to comply with the written description requirement pursuant to §112, first paragraph because the “electrical controller” limitation was added in a new claim and is not explicitly recited in the specification, no such in haec verba requirement exists (MPEP §2163.I.B.). Instead, the written description prong of §112 requires that claim limitations be supported in the specification through express, implicit, or

inherent disclosure. Because the specification clearly describes an electrical controller, claims 85-90 comply with the written description requirement of §112.

As such, Applicant respectfully requests withdrawal of the §112 rejections of these claims.

Claim Rejections-35 U.S.C. §102

Claims 85 and 89-91 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Patent No. 6,080,170, issued to Nash, et al. ("Nash"). Applicant respectfully traverses this rejection, since Nash does not disclose each and every element required by these claims.

In contrast to Nash, independent claim 85 requires an electrical controller "for controlling positioning of said at least one of said shafts." Despite this, the Examiner has essentially stated that this claim limitation recites an intended use and does not constitute a limitation in any patentable sense. While Applicant is fully aware that an "intended use" limitation has no patentable weight, the "controlling positioning" limitation is not an intended use limitation, but rather a functional limitation that must be given patentable weight. The Patent Office has stated:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.

* * *

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. M.P.E.P. §2173.05(g).

While the controller of Nash is capable of actuating a tool at the end of the inner shaft, such controller is not configured to control the position of one of the shafts, and the Examiner has not

concluded otherwise. In this sense, the “control positioning” claim limitation does not attempt to distinguish Nash on the basis of an intended use (since the controller of Nash does not control the positioning of one of the shafts), but rather distinguishes Nash on the basis of a proper functional limitation that Nash does not disclose. In fact, one would actually have to significantly modify the Nash device for the controller to control the positioning of one of the shafts.

With respect to independent claim 91, the Examiner has stated that the claimed method is inherently carried out by the Nash controller. Applicant disagrees. The fact that it is possible to perform an undisclosed process with a prior art device does not mean that the process is anticipated by the prior art device or the disclosure thereof. The Examiner should note that “under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device.” (See M.P.E.P. §2112.02)(emphasis added).

Thus, even if it were possible for the Nash controller to control the position of one of the shafts (which it cannot absent significant modification), in the normal and usual operation of the Nash device, the Nash controller does not control the position of one of the shafts. Therefore, Nash does not inherently disclose the process recited in claim 91.

Thus, Applicant respectfully believes that claims 85 and 89-91 are not anticipated by Nash, and as such, request withdrawal of the §102 rejection of these claims.

Allowable Subject Matter

Claims 86-88 and 92-94 stand objected to as depending from a rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. While Applicant graciously acknowledges the Examiner’s

indication that these claims contain allowable subject matter, it is believed that claims 86-88 and 92-94 are allowable by virtue of their dependency from independent claims 85 and 91, which are believed to be allowable over the cited prior art, as discussed above. As such, Applicant respectfully requests withdrawal of the objections of these claims.

Conclusion

Based on the foregoing, it is believed that all claims are allowable, and thus, a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (949) 724-1849.

Respectfully submitted,

VISTA IP LAW GROUP LLP

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By: 

Michael J. Bolan
Reg. No. 42,339

Customer No. 41696
Vista IP Law Group LLP
12930 Saratoga Ave., Suite D-2
Saratoga, CA 95070